

REMARKS

By this amendment, Applicants add a new claim (9) combining the limitations of claim 1 and 2, without canceling either claim 1 or 2.

After this amendment, claims 1-4 and 6-9 remain pending in the application, claim 5 having been canceled previously. Applicants have amended the claims only to make them consistent in regard to a proper antecedent basis. Applicants submit that for the following reasons the pending claims define over the applied prior art.

The present amendment adds no new matter to the application.

The Rejections

Claims 1-4 and 6-8 stand rejected under 35 U.S.C §103(a).

Applicants' Arguments

In response to the rejection of claim 1-4 and 6-8 under 35 U.S.C. §103(a) over Hu et al. (US 5,929,324, hereafter Hu) in view of Karlson (US 5,069,880, mistakenly identified by the examiner as “Karlson”) and Dosoretz et al. (US 5,604,298, hereafter Dosoretz), first of all, Applicants submit that there is no motivation to combine the three references as the Examiner has done. No such motivation is provided by these references either individually or in combination. In fact, each reference describes a different and

separate invention from the Applicants' invention. Nor has the Examiner presented a justifiable reason to combine them other than merely copying the Applicants' reasons for their invention. Applicants' own teachings cannot be used as a basis.

However, even if the references were combined as the Examiner suggests, the combination does not make obvious the claimed invention.

Specifically, in regard to claim 1, contrary to the Examiner's assertion that Hu discloses a method for inspecting (detecting) leakage of a container, Hu is directed to detecting gas leakage in an ozone generating system comprising an ozone generating unit such as 12 and the piping system such as 32,34,50 and 60. The Examiner does not identify the claimed container which is being tested for a leakage. In fact, Hu is not directed to detecting leakage in a container. Rather, the leakage detection in Hu is designed for detecting a leakage in a stationary plant system for generating ozone.

Furthermore, the Examiner admits that Hu fails to disclose the claimed differential pressure generation step (page 3 of the office action). The Examiner uses Karlson to provide the step of the differential pressure generation. However, Applicants disagree with the Examiner. Specifically, Applicants submit that Karlson is merely directed to the sterilizing of objects by ozone. Any measurement of pressure in Karlson is performed to make sure that the sterilization of the objects proceeds at a desired rate, not to perform the claimed detection of a leakage in a container. Besides, the Examiner has not shown how the measurement of pressure in Karlson can be incorporated in the Hu's system and why a person of ordinary skill would look to Karlson to modify Hu. Each of Hu and Karlson are separate inventions and neither calls for a need for the other.

Furthermore, the Examiner employs Dosoretz to show a leakage determination step. Dosoretz shows in figure 1 a system where two test units 20 and 26 measure the concentration of a selected gas (say ozone) at different locations 22 and 28 and detect a

leakage by comparing the two measurements with a reference concentration. Dosoretz at best shows a generic device and method of measuring a leakage in a system such as an ozone producing unit 10 in figure 1. It teaches nothing to apply the disclosed concentration measuring device and method to measure the claimed leakage detection of a container.

Therefore, even the combination of Hu, Karlson and Dosoretz fails to teach the limitations of claim 1 and its rejection should be reconsidered and withdrawn.

The independent claim 8 similarly defines over the combination of Hu, Karlson and Dosoretz. Claims 2-4 and 6 depend on claim 1 and contain at least the limitations of claim 1 and are, therefore, patentable over Hu, Karlson and Dosoretz.

Regarding claims 7 and 9, each contains an additional limitation of "a storage container for storing the container therein in a sealed state" (claim 7, and the corresponding limitation in method claim 9), that is not shown in any of the references. Consequently, claims 7 and 9 are further patentable over Hu, Karlson and Dosoretz.

Thus, the Examiner has not made a *prima facie* case of obviousness to reject claims 1-4 and 6-8. Therefore, the rejection of claims 1-4 and 6-8 should be withdrawn. For the same reason, new claim 9 is not rejectable.

Conclusion

For all the above reasons, we believe that the rejection under 35 U.S.C. §103 is not sustainable and should be withdrawn. Therefore, this application is in condition for allowance. The favor of a telephone call is requested in case there is a question.

Respectfully submitted,

GRiffin & Szipl, P.C.



Joerg-Uwe Szipl
Registration No. 31,799

GRiffin & Szipl, P.C.
Suite PH-1
2300 Ninth Street, South
Arlington, VA 22204

Telephone: (703) 979-5700
Facsimile: (703) 979-7429
Email: GANDS@szipl.com
Customer No.: 24203